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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,387	12/23/2003	Masahiko Matsukawa	21581-00314-US	7938

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EXAMINER

JENKINS, DANIEL J

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/743,387

Applicant(s)

MATSUKAWA ET AL.

Examiner

Daniel J. Jenkins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 16 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,8,10,11,15 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,8,10,11,15 and 17-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The Examiner has carefully considered Applicant's Response of 3/16/06. At this time, the Examiner makes a new rejection in order to more fully anticipate Applicant's claimed invention.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 3-5, 8, 10, 11, 15 and 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO99/14399 (WO'399) in view of Carey et al. and further in view of Wada et al

WO'399 discloses the invention substantially as claimed. WO'399 discloses a conversion coating method comprising:

providing a chemical conversions coating upon a substrate;

wherein the chemical conversion coating agent comprises

at least one of an additional compound selected from a group comprising zirconium, tantalum and fluorine (page 5, lines 23-28) ; and

an amino containing silane group compound that falls within the group as claimed by Applicant, establishing a prima facie case of obviousness. (page 5, lines 10-21).

WO'399 further discloses wherein said agent has a pH of less than 5 (page 6, liens 20-24), overlapping Applicant's claimed range establishing a prima facie case of obviousness.

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WO'399 further discloses wherein said additional compound is added to the agent in amounts which overlap the range as claimed by Applicant, establishing a prima facie case of obviousness.

WO'399 further discloses additional material added to the conversion coating that fall within Applicant's claimed invention,

However, WO'399 does not disclose wherein the substrate is an iron alloy substrate.

Carey et al. teaches that similar coatings can be applied to both iron and aluminum, and further teaches additional agents within the coating agent to promote adhesion.

It would have been obvious to one having ordinary skill in the art to apply the coating of WO'399 to iron substrates as well as aluminum substrates as taught by Carey et al. and to provide adhesion promoting agents as taught by Carey et al. to the invention of WO'399.

However, WO'399 does not disclose wherein the agent further comprises an accelerator.

Wada et al. teaches in the same field of endeavor that accelerators including compounds as claimed by Applicant can be used in conversion coatings to improve the effect of the coating upon the substrate.

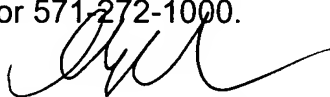
It would have been obvious to one of ordinary skill in the art at the time of the invention to use an accelerator as taught by Wada et al. in the invention of WO'399 in order to improve the effectiveness of the coating upon the substrate.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Jenkins whose telephone number is 571-272-1242. The examiner can normally be reached on M-TH6:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1242. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Daniel J. Jenkins
Primary Examiner
Art Unit 1742

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